ZILKA·KOTAB
PC
ZILKA, KOTAB & FEECE ™

100 PARK CENTER PLAZA, SUITE 300
SAN JOSE, CA 95113

TELEPHONE (408) 971-2573
FAX (408) 971-4660

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From:	Dominic M. Kotab		

Docket No.: NAIIP315_01.180.01   **App. No: 10/075,722**

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Practitioner's Docket No. NAI1P315/01.180.01   *PATENT*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Luke David Jagger et al.

Application No.: 10/075,722   Group No.: 2176
Filed: February 14, 2002   Examiner: Blackwell, J.
For: METHOD AND SYSTEM FOR IDENTIFYING UNSOLICITED MAIL UTILIZING
       CHECKSUMS

Mail Stop Appeal Briefs – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION–37 C.F.R. § 41.37)

1.   Transmitted herewith, is the APPEAL BRIEF in this application, with respect to the Notice of
      Appeal filed on January 20, 2006.

2.   STATUS OF APPLICANT

      This application is on behalf of other than a small entity.

CERTIFICATION UNDER 37 C.F.R. ' ' 1.8(a) and 1.10*
(When using Express Mail, the Express Mail label number is *mandatory;*
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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_ deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

       37 C.F.R. § 1.8(a)   37 C.F.R. § 1.10*
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Date: 4/20/2006

                                                            Erica L. Farlow
                                                            (type or print name of person certifying)

* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Transmittal of Appeal Brief –page 1 of 2

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

other than a small entity	$500.00
Appeal Brief fee due	**$500.00**

4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant petitions for an extension of time under 37 C.F.R. § 1.136 (fees: 37 C.F.R. § 1.17(a)(1)-(5)) for one month:

Fee: $120.00

If an additional extension of time is required, please consider this a petition therefor.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee	$500.00
Extension fee (if any)	$120.00
TOTAL FEE DUE	**$620.00**

6. FEE PAYMENT

Authorization is hereby made to charge the amount of $620.00 to Deposit Account No. 50-1351.

A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1351 (order number NAI1P315).

_____
Signature of Practitioner
Dominic M. Kotab
Zilka-Kotab, PC
P.O. Box 721120
San Jose, CA 95172-1120
USA

Reg. No.: 42,762
Tel. No.: 408-971-2573
Customer No.: 28875

Transmittal of Appeal Brief—page 2 of 2

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	)
	)
Luke David Jagger et al.	) Group Art Unit: 2176
	)
Application No. 10/075,722	) Examiner: Blackwell, James H.
	)
Filed: February 14, 2002	) Date: April 20, 2006
	)
For: METHOD AND SYSTEM FOR	)
IDENTIFYING UNSOLICITED MAIL	)
UTILIZING CHECKSUMS	)
	)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPEAL BRIEF (37 C.F.R. § 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on January 20, 2006.

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)(i)):

<table>
<tr><td>I</td><td>REAL PARTY IN INTEREST</td></tr>
<tr><td>II</td><td>RELATED APPEALS AND INTERFERENCES</td></tr>
<tr><td>III</td><td>STATUS OF CLAIMS</td></tr>
<tr><td>IV</td><td>STATUS OF AMENDMENTS</td></tr>
<tr><td>V</td><td>SUMMARY OF CLAIMED SUBJECT MATTER</td></tr>
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<tr><td>VII</td><td>ARGUMENTS</td></tr>
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The final page of this brief bears the practitioner's signature.

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I REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))

The real party in interest in this appeal is McAfee, Inc.

)

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II RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c) (1)(ii))

With respect to other prior or pending appeals, interferences, or related judicial proceedings that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no other such appeals, interferences, or related judicial proceedings.

A Related Proceedings Appendix is appended hereto.

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III STATUS OF CLAIMS (37 C.F.R. § 41.37(c) (1)(iii))

A.   TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-5 and 8-24

B.   STATUS OF ALL THE CLAIMS IN APPLICATION

1.   Claims withdrawn from consideration: None
2.   Claims pending: 1-5 and 8-24
3.   Claims allowed: None
4.   Claims rejected: 1-5 and 8-24
5.   Claims cancelled: 6-7 and 25

C.   CLAIMS ON APPEAL

The claims on appeal are: 1-5 and 8-24

See additional status information in the Appendix of Claims.

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IV STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))

As to the status of any amendment filed subsequent to final rejection, there are no such amendments after final.

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V SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))

With respect to a summary of Claims 1, 13 and 18, as shown in Figure 8, a system, method and computer program product are provided for identifying unsolicited electronic mail messages in a computer network. In use, an electronic mail message is received (e.g. item 80 of Figure 8). Non-static data, including visible end-of-line characters and headers, are removed from the electronic mail message (e.g. item 82 of Figure 8). A checksum based on data remaining within the electronic mail message is then generated (e.g. item 86 of Figure 8). Additionally, the generated checksum is compared with a database containing checksums for previously identified unsolicited messages (e.g. item 88 of Figure 8). Further, the electronic message is identified as an unsolicited message if the generated checksum matches one of the database checksums (e.g. item 91 of Figure 8). Still yet, the non-static data is removed to prevent the non-static data from being subject to the checksum, so that non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message. See page 11, lines 1-7 and page 14, lines 1-11, for example.

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VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. § 41.37(c)(1)(vi))

Following, under each issue listed, is a concise statement setting forth the corresponding ground of rejection.

Issue # 1: The Examiner has rejected Claims 1-3, 5, 8-15, 17-18, 20 and 24 under 35 U.S.C. 102(b) as being anticipated by Ralston et al. (U.S. Patent No. 6,842,773).

Issue # 2: The Examiner has rejected Claims 4, 16, 19 and 21-23 under 35 U.S.C. 103(a) as being unpatentable over Ralston (U.S. Patent No. 6,842,773).

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VII ARGUMENTS (37 C.F.R. § 41.37(c)(1)(vii))

The claims of the groups noted below do not stand or fall together. In the present section, appellant explains why the claims of each group are believed to be separately patentable.

Issue # 1:

The Examiner has rejected Claims 1-3, 5, 8-15, 17-18, 20 and 24 under 35 U.S.C. 102(b) as being anticipated by Ralston et al. (U.S. Patent No. 6,842,773).

   Group #1: Claims 1, 2, 8-10, 13-14, 17, 18 and 20

With respect to each of the independent claims, the Examiner has relied on step 708 in Figure 7A of Ralston to make a prior art showing of appellant's claimed "removing non-static data including visible end-of-line characters and headers, from the electronic mail message" (see the same or similar, but not necessarily identical language in each of the independent claims).

Appellant respectfully asserts that item 708 specifically shows "strip[ping] headers and hidden information to leave visible text body of message." Clearly, removing <u>hidden</u> information, as taught in Ralston, does not meet, and actually even *teaches away* from, appellant's claimed "removing <u>non-static</u> data including <u>visible</u> end-of-line characters" (emphasis added).

In the Advisory Action dated January 11, 2006, the Examiner has responded to appellant's arguments by stating that "end-of-line characters are typically, from the point of view of an observer, hidden in the sense that they are not visible unless made so by representing them with a character...or other symbol that is visible" and that "rendering such characters 'visible' for purposes of detection would only make sense if the detector relied on a visual or optically-detectable means."

Appellant respectfully asserts that what is specifically claimed is "removing non-static data including <u>visible</u> end-of-line characters and headers, from the electronic mail message" (emphasis added). In contrast, Ralston discloses removing <u>hidden</u> information. First, this does not meet appellant's "visible end-of-line characters," as claimed. Second, the Examiner's statements above

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appear to be based on an inherency argument because, while Ralston fails to disclose the same, the Examiner seems to be arguing that appellant's claimed feature "would only make sense." It is noted, however, that appellant's claim language would <u>not</u> be inherent in view of Ralston since, as argued above, Ralston's disclosure is a classic example of *teaching away* from appellant's claim language, thereby undermining any inherency argument.

It thus appears that the Examiner has relied on an inherency argument regarding the above emphasized claim limitations. In view of the arguments made hereinabove, any such inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

Still with respect to each of the independent claims, the Examiner has relied on Col. 14, lines 10-20 and Col. 13, lines 7-14 in Ralston to make a prior art showing of appellant's claimed technique "wherein the non-static data is removed to prevent the non-static data from being subject to the checksum, so that non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message." Appellant respectfully asserts that such excerpt only teaches removing headers or hidden information which "could potentially confuse processing of the message." However, as argued above, Ralston does not teach removing non-static data in the manner claimed by appellant, and especially not "so that non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message," as specifically claimed by appellant (emphasis added).

In the Advisory Action dated January 11, 2006, the Examiner has failed to even respond to appellant's specific arguments. Thus, appellant again emphasizes that simply nowhere does Ralston teach removing the non-static data such that "non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message," as appellant specifically claims.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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Moreover, the identical invention must be shown in as complete detail as contained in the claim. Richardson v. Suzuki Motor Co.868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. This criterion has simply not been met by the Ralston reference, as noted above.

Group #2: Claims 3 and 15

The Examiner has relied on Figures 7A-7D in Ralston to make a prior art showing of appellant's claimed technique "wherein the portions comprise lines of data." Appellant respectfully asserts that Figures 7A and 7B merely relate to forming a fingerprint for each word, whereas Figures 7C and 7D relate to forming a fingerprint for groups of characters. Simply nowhere in Ralston is there any disclosure of individual checksums for portions of data, where such portions include lines of data, in the context claimed by appellant.

Again, appellant respectfully asserts that the Ralston reference fails to meet all of appellant's claim language, as noted above.

Group #3: Claim 5

The Examiner has relied on Figures 5A-5F in Ralston to make a prior art showing of appellant's claimed "deleting the electronic mail message if the message is identified as an unsolicited message." Appellant respectfully asserts that such Figures only disclose "Move to Bulk Mail Folder" when the e-mail is determined to be suspect. Clearly, moving an e-mail to a folder does not meet "deleting the electronic mail message," as specifically claimed by appellant (emphasis added).

Again, appellant respectfully asserts that the Ralston reference fails to meet all of appellant's claim language, as noted above.

Group #4: Claim 11

- 12 -

With respect to appellant's claimed "updating the database with new checksums," the Examiner has simply stated that Ralston teaches that "[a]ny message unique to the mail system has its fingerprint stored in the message database (206) to allow for matching to subsequent messages." However, the Examiner has failed to note any specific excerpt from Ralston that teaches such claim language. Appellant notes that Ralston only teaches that "[i]f there is <u>no match</u>, the fingerprint for the message is added to the store(s) in step 682" (emphasis added). Appellant further notes that such store is only utilized "[t]o determine if the e-mail message 400 has been sent a number of times over a given time period" (see Ralston, Col. 9, line 65-Col. 10, line 10). Thus, simply nowhere in Ralston is there any disclosure of "updating the database with new checksums" where such database contains "checksums for previously identified unsolicited messages" in the context claimed by appellant (see independent claims for context).

Again, appellant respectfully asserts that the Ralston reference fails to meet <u>all</u> of appellant's claim language, as noted above.

> *Group #5: Claim 12*

Again, with respect to the subject matter of Claim 12, the Examiner has simply stated that Ralston teaches that "[a]ny message unique to the mail system has its fingerprint stored in the message database (206) to allow for matching to subsequent messages." However, the Examiner has failed to note any specific excerpt from Ralston that teaches such claim language. Appellant notes that Ralston only teaches that "[i]f there is <u>no match</u>, the fingerprint for the message is added to the store(s) in step 682" (emphasis added). Appellant further notes that such store is only utilized "[t]o determine if the e-mail message 400 has been sent a number of times over a given time period" (see Ralston, Col. 9, line 65-Col. 10, line 10). Thus, simply nowhere in Ralston is there any disclosure of a "database [that] is updated based on checksums generated from electronic messages received <u>and identified as an unsolicited message</u>" (Claim 12 et al.- emphasis added).

Again, appellant respectfully asserts that the Ralston reference fails to meet <u>all</u> of appellant's claim language, as noted above.

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Group #6: Claim 24

The Examiner has simply relied on the rejections made with respect to Issue #1, Group #1 above to make a prior art showing of appellant's claimed technique "wherein the non-static data is removed prior to the checksum being generated." For substantially the same reasons as argued above with respect to each of the independent claims, appellant respectfully assert that Ralston's <u>hidden</u> information does not meet appellant's claimed "non-static data."

Again, appellant respectfully asserts that the Ralston reference fails to meet <u>all</u> of appellant's claim language, as noted above.

<u>Issue # 2:</u>

The Examiner has rejected Claims 4, 16, 19 and 21-23 under 35 U.S.C. 103(a) as being unpatentable over Ralston.

Group #1: Claims 4, 16, 21 and 23

The Examiner has argued that "it is notoriously well known in the art to make comparisons between items in any order [and that t]herefore it would have been obvious to one of ordinary skill in the art at the time of the invention to compare checksums in either direction (top to bottom, or bottom to top) providing the benefit of identifying unsolicited emails."

Further, the Examiner has responded to appellant's arguments that simply because it is allegedly well known to make comparisons between items in any order, as the Examiner contends, such does not make appellant's specific claim language obvious. In particular, the Examiner has argued that appellant's claim language is confusing as to the motivation for "comparing a checksum comprises comparing checksums starting with one of the portions at the end of the remaining data and working backwards through the data." The Examiner has argued that such claim language seems moot in light of the prior removal of non-static material when read in view of the specification (Page 11, lines 14-19).

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Appellant respectfully disagrees with this assertion. Simply because it is allegedly well known to make comparisons between items in any order, as the Examiner contends, such does not make appellant's specific claim language obvious. Appellant does not merely claim comparing items in any order, but claims, in the relevant claim(s), comparing checksums <u>for each portion of remaining data</u> starting at the end of the remaining data and working backwards through the data. Thus, each portion of remaining data has an associated checksum which is compared starting at the end of the remaining data, working through to the beginning of the remaining data. Thus, such feature would not be obvious in view of the claimed context of such comparing and in view of the advantages thereof, namely in order to reduce required processing.

Thus, it seems the Examiner has simply dismissed such claim language under Official Notice. In response, appellant again points out the remarks above that clearly show that such claim language would not have been obvious. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

"If the appellant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position." See MPEP 2144.03.

Group #2: Claim 19

Appellant respectfully asserts that the subject matter of such claims is deemed novel in view of the arguments made hereinabove with respect to Issue #1, Group #1.

Group #3: Claim 22

Appellant respectfully asserts that the subject matter of such claims is deemed novel in view of the arguments made hereinabove with respect to Issue #1, Group #3.

In view of the remarks set forth hereinabove, all of the independent claims are deemed allowable, along with any claims depending therefrom.

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VIII APPENDIX OF CLAIMS (37 C.F.R. § 41.37(c)(1)(viii))

The text of the claims involved in the appeal (along with associated status information) is set forth below:

1. (Previously Presented) A method for identifying unsolicited electronic mail messages in a computer network, comprising:
receiving an electronic mail message;
removing non-static data including visible end-of-line characters and headers, from the electronic mail message;
generating a checksum based on data remaining within the electronic mail message;
comparing the generated checksum with a database containing checksums for previously identified unsolicited messages; and
identifying the electronic message as an unsolicited message if the generated checksum matches one of the database checksums;
wherein the non-static data is removed to prevent the non-static data from being subject to the checksum, so that non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message.

2. (Original) The method of claim 1 wherein generating a checksum comprises generating individual checksums for portions of the remaining data.

3. (Original) The method of claim 2 wherein the portions comprise lines of data.

4. (Original) The method of claim 2 wherein comparing a checksum comprises comparing checksums starting with one of the portions at the end of the remaining data and working backwards through the data.

5. (Original) The method of claim 1 wherein removing non-static material comprises removing forwarding information.

6. – 7. (Cancelled)

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8. (Original) The method of claim 1 further comprising deleting the electronic mail message if the message is identified as an unsolicited message.

9. (Original) The method of claim 1 further comprising at least temporarily storing the electronic message if the message is identified as an unsolicited message.

10. (Original) The method of claim 1 further comprising forwarding the electronic message to an intended recipient if the message is not identified as an unsolicited message.

11. (Original) The method of claim 1 further comprising updating the database with new checksums.

12. (Original) The method of claim 11 wherein the database is updated based on checksums generated from electronic messages received and identified as an unsolicited message.

13. (Previously Presented) A system for identifying unsolicited electronic mail messages in a computer network, comprising:

a message modifier operable to remove non-static data including visible end-of-line characters and headers, from an electronic mail message;

a checksum generator operable to generate a checksum based on data remaining within the electronic mail message;

a database containing checksums previously identified for unsolicited messages; and

a detector operable to compare the generated checksum with the database and identify the electronic message as an unsolicited message if the generated checksum matches one of the database checksums;

wherein the non-static data is removed to prevent the non-static data from being subject to the checksum, so that non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message.

14. (Original) The system of claim 13 wherein the detector is configured to generate individual checksums for portions of the remaining data.

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15. (Original) The system of claim 14 wherein the portions comprise lines of data.

16. (Original) The system of claim 14 wherein the detector is configured to compare the generated checksums starting with one of the portions at the end of the data and working backwards through the data.

17. (Original) The system of claim 13 wherein the database is configured to receive updates.

18. (Previously Presented) A computer program product for identifying unsolicited electronic mail messages in a computer network, comprising:
code that receives an electronic mail message;
code that removes non-static data including visible end-of-line characters and headers, from the electronic mail message;
code that generates a checksum based on data remaining within the electronic mail message;
code that compares the generated checksum with a database containing checksums for previously identified unsolicited messages;
code that identifies the electronic message as an unsolicited message if the generated checksum matches one of the database checksums; and
a computer readable medium that stores said computer codes;
wherein the non-static data is removed to prevent the non-static data from being subject to the checksum, so that non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message.

19. (Previously Amended) The computer product of claim 18 wherein the computer readable medium is selected from the group consisting of CD-ROM, floppy disk, tape, flash memory, system memory, and hard drive.

20. (Original) The computer product of claim 18 further comprising code that generates individual checksums for portions of the remaining data.

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21. (Original) The computer product of claim 20 further comprising code that compares the generated checksums starting with one of the portions at the end of the data and works backwards through the data.

22. (Previously Presented) The method of claim 5 wherein the forwarding information includes a ">" character.

23. (Previously Presented) The method of claim 4 wherein the comparing starts with one of the portions at the end of the remaining data and works backwards through the data, in order to reduce required processing.

24. (Previously Presented) The method of claim 1 wherein the non-static data is removed prior to the checksum being generated.

25. (Cancelled)

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IX APPENDIX LISTING ANY EVIDENCE RELIED ON BY THE APPELLANT IN THE APPEAL (37 C.F.R. § 41.37(c)(1)(ix))

There is no such evidence.

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X RELATED PROCEEDING APPENDIX (37 C.F.R. § 41.37(c)(1)(x))

There is no such related proceeding.

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In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NAI1P315/01.180.01).

Respectfully submitted,

By: _____ Date: _____ 04/20/06 _____

Dominic M. Kotab

Reg. No. 42,762

Zilka-Kotab, P.C.
P.O. Box 721120
San Jose, California 95172-1120
Telephone: (408) 971-2573
Facsimile: (408) 971-4660